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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,576	07/27/2001	Noriko Yagi	1403-0214P	8192

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER  
WYROZEBSKI LEE, KATARZYNA I

ART UNIT PAPER NUMBER

1714

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/915,576

Applicant(s)

YAGI ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Stuhldreher (US 6,080,809) or its equivalent EP 894,819.

The prior art of Stuhldreher discloses composition for tread of a passenger tire. The composition according to Table I comprises:

Solution SBR	90.75 with (SBR 75 pbw)
Cis BR	25 pbw
N110 carbon black	41 pbw
Silica	30 pbw
Clay	10 pbw
Silane coupling agent	6 pbw

From the above information, it is clear that the amount of clay and silica is more than 30 pbw and the amount of carbon black, silica and clay is less than 100 pbw.

The properties of the components according to the specification are as follows: Clay has median particle size of from about 0.2 microns, which is less than 10 (col. 2, lines 16-18). Preferred silane coupling agent is Si69 (col. 2, lines 25-26). Silica has  $N_2SA$  of 190-220  $m^2/g$  (col. 2, lines 35-36). Although the nitrogen absorption of N110 is not specifically described in the prior art of Stuhldreher, one of ordinary skill in the art with knowledge of reinforcing carbon blacks would know that it is approximately 125  $m^2/g$  either from other documents cited in this office action or from website [www.stochem.com](http://www.stochem.com) (courtesy copy provided at the end of this office action).

In the light of the above disclosure, the prior art of Stuhldreher anticipates requirements of claims rejected above.

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3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hergenrother (US 6,342,552).

The prior art of Hergenrother discloses composition for tire treads. According to the examples of the prior art of Hergenrother disclosed in examples in columns 18-20, the main rubber component is either 100 pbw of SBR or 75/25 of SBR/PB (Tables VI and VII, col. 18, 19). Table IX further contains combination of the fillers utilized in the rubber composition. Specifically Example 34 comprises 35 pbw silica, 8 pbw carbon black and 5 pbw clay. Table IX discloses formulation from Table VIII modify so that mineral filler replaces part of silica filler. The total amount of silica and clay is more than 30 pbw and the total amount of fillers is below 100 pbw. Silane coupling agent, if utilized is Si69 from Degussa in an amount of 1 pbw when silica is utilized (Table VIII).

According to the Table I (col. 9) carbon blacks have nitrogen surface area of 35-126 m<sup>2</sup>/g. Silicas have preferred surface area of 100-250 m<sup>2</sup>/g.

In the light of the above disclosure, the prior art of Hergenrother anticipates the requirements of claims rejected above.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hergenrother (US 6,525,118) equivalent to disclosure of Hergenrother applied in the rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
KIWL  
June 3, 2003